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EXAMINER	
WASSUM, LUKE S	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/665,237	POLTORAK, ALEXANDER I.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-33,36-59,62-83 and 86-100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 13-17, 19-33, 37-41, 43-59, 62-67,69-83 and 86-100* is/are rejected.

7)☒ Claim(s) *12,18,36,42 and 68* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 7 December 2007, has been received, entered into the record, and considered.

2. As a result of the amendment, claims 1-4, 7-10, 12-24, 26-33, 36-48, 50-53, 56, 58, 59, 62-74, 76-83, 86-98 and 100 have been amended, and claims 11, 34, 35, 60, 61, 84, 85, have been canceled. Claims 1-10, 12-33, 36-59, 62-83 and 86-100 remain pending in the application.

The Invention

3. The Applicant's specification discloses a method and apparatus for identifying/analyzing potential patent infringement.

Priority

4. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Patent Application 60/419,184, filed on 17 October 2002, is acknowledged.

Specification

5. In view of the Applicant's amendment to the specification, the pending objection to the specification is withdrawn.

Double Patenting

6. In view of the claim amendments, the pending rejection based upon statutory double patenting is withdrawn.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van*

Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-10, 12-33, 36-59, 62-83 and 86-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-88 of U.S. Patent No. 7,296,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejected claims of the instant invention would be anticipated by claims 1-88 of the issued patent.

9. In view of the amendment to claims 3, 13, 15, 29, 39, 65 and 89, the pending claim objections are withdrawn.

Claim Rejections - 35 USC § 112

10. In view of the amendment to claim 77, the pending claim rejections under 35 U.S.C. § 112 second paragraph are withdrawn.

Claim Rejections - 35 USC § 101

11. In view of the amendment to claims 27 and 77, then pending claim rejections under 35 U.S.C. § 101 are withdrawn.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755).

15. Regarding claim 1, **Snyder et al.** teaches an apparatus for identifying potential patent infringement substantially as claimed, comprising:

a) an input device for inputting information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

b) a processing device for processing the information regarding the patent (see processors 30 and 30' in drawing Figure 1A, et seq.), wherein the processing device is configured to:

i) identify at least one claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);

ii) parse the at least one claim to identify at least one term in the at least one claim (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.; see also disclosure of the processing of claims to extract relevant terms and generate vectors, col. 13, line 12 through col. 15, line 67);

iii) formulate a search query comprising the at least one term (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34; see also col. 4, lines 49-62);

iv) obtain information regarding at least one of a product, products, a service, and services (see disclosure that both structured and non-structured documents can be searched, said structured documents

including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45);

v) perform a search of the information regarding at least one of a product, products, a service and services using the search query (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45); and

c) an output device for outputting result of the search (see drawing Figure 10C et seq.).

Snyder et al. does not explicitly teach an apparatus wherein the search query includes a foreign language translation of the at least one term.

Hammond, however, teaches an apparatus wherein the search query includes a foreign language translation of the at least one term (see disclosure that queries may be expanded to include terms related to the query terms entered by the user, referred to as unentered terms, col. 4, lines 32-44; see also disclosure that the language resolver will

perform query expansion by including unentered terms such as various foreign language equivalents of user-entered query terms, col. 7, lines 11-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include foreign language translations of query terms, since this would allow the query engine to search for and locate relevant information in languages other than English, col. 7, lines 17-20.

16. Regarding claim 27, **Snyder et al.** teaches an apparatus for analyzing potential patent infringement substantially as claimed, comprising:

a) a receiver for receiving information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

b) a processing device for processing the information regarding the patent (see processors 30 and 30' in drawing Figure 1A, et seq.), wherein the processing device is configured to:

i) identify at least one claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);

ii) parse the at least one claim to identify at least one term in the at least one claim (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.; see also disclosure of the processing of claims to extract relevant terms and generate vectors, col. 13, line 12 through col. 15, line 67);

iii) formulate a search query comprising the at least one term (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34; see also col. 4, lines 49-62);

iv) generate a claim chart (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

v) perform a search of the information regarding at least one of a product, and a service using the query (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45); and

c) a transmitter for transmitting the information contained in the claim chart to a user communication device in order to display the claim chart (see drawing Figure 10C et seq.; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

Snyder et al. does not explicitly teach an apparatus wherein the search query includes a foreign language translation of the at least one term.

Hammond, however, teaches an apparatus wherein the search query includes a foreign language translation of the at least one term (see disclosure that queries may be expanded to include terms related to the query terms entered by the user, referred to as unentered terms, col. 4, lines 32-44; see also disclosure that the language resolver will perform query expansion by including unentered terms such as various foreign language equivalents of user-entered query terms, col. 7, lines 11-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include foreign language translations of query terms, since this would allow the query engine to search for and locate relevant information in languages other than English, col. 7, lines 17-20.

17. Regarding claim 51, **Snyder et al.** teaches a computer-implemented method for analyzing potential patent infringement substantially as claimed, comprising:

a) inputting information regarding a patent into a processing device (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

b) processing the information regarding the patent with the processing device (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25);

c) identifying a claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);

d) parsing the claim to identify at least one term in the claim (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.; see also disclosure of the processing of claims to extract relevant terms and generate vectors, col. 13, line 12 through col. 15, line 67);

e) formulating a search query containing the at least one term (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34);

f) searching information regarding at least one of a product, products, a service, and services using the query (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);

g) generating claim chart information containing at least some of the information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

h) outputting the claim chart information (see drawing Figure 10C et seq.).

Snyder et al. does not explicitly teach a method wherein the search query includes a foreign language translation of the at least one term.

Hammond, however, teaches a method wherein the search query includes a foreign language translation of the at least one term (see disclosure that queries may be expanded to include terms related to the query terms entered by the user, referred to as unentered terms, col. 4, lines 32-44; see also disclosure that the language resolver will perform query expansion by including unentered terms such as various foreign language equivalents of user-entered query terms, col. 7, lines 11-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include foreign language translations of query

terms, since this would allow the query engine to search for and locate relevant information in languages other than English, col. 7, lines 17-20.

18. Regarding claim 77, **Snyder et al.** teaches a computer-implemented method for analyzing potential patent infringement substantially as claimed, comprising:

a) receiving information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

b) processing the information regarding the patent (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25);

c) identifying a claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);

d) formulating a search query containing terms in the claim (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison

between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34);

e) searching information regarding at least one of a product, products, a service, and services using the query (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);

f) generating claim chart information containing at least some of the information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

g) transmitting the claim chart information to a user communication device in order to display the claim chart to a user (see drawing Figure 10C et seq.; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

Snyder et al. does not explicitly teach a method wherein the search query includes a foreign language translation of the at least one term.

Hammond, however, teaches a method wherein the search query includes a foreign language translation of the at least one term (see disclosure that queries may be expanded to include terms related to the query terms entered by the user, referred to as unentered terms, col. 4, lines 32-44; see also disclosure that the language resolver will perform query expansion by including unentered terms such as various foreign language equivalents of user-entered query terms, col. 7, lines 11-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include foreign language translations of query terms, since this would allow the query engine to search for and locate relevant information in languages other than English, col. 7, lines 17-20.

19. Regarding claims 2 and 52, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a laptop or notebook computer (see disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

20. Regarding claims 3 and 29, **Snyder et al.** additionally teaches an apparatus further comprising a database (see dataset 10a in drawing Figure 1B; see also disclosure that a dataset is a document database, col. 7, lines 64-66), wherein the database contains product descriptions (see disclosure that both structured and non-structured documents can be searched, said non-structured documents including technical publications, non-structured portions of structured documents, etc., col. 20, lines 29-36; see also the text of claim 11, disclosing that the documents are attributable to a product, col. 29, lines 34-35).

21. Regarding claims 4 and 54, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a transmitter for transmitting at least one of an information request to an information source computer and a claim chart information to a user communication device (see drawing Figure 10C; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

22. Regarding claims 5 and 55, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a receiver for receiving at least one of patent information from a user communication device and a response to a request for information from an information source computer (see disclosure that the user enters a

patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53; see also col. 10, lines 20-33).

23. Regarding claims 6, 30, 56 and 80, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device at least one of processes and parses the text information of the patent in order to identify the claims of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.).

24. Regarding claims 7, 31, 57 and 81, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to automatically utilize at least one of a word processing searching technique, a text analysis processing technique, and a semantic analysis processing technique, to identify the claims of the patent (see col. 12, lines 42-67 et seq.).

25. Regarding claims 8, 32, 58 and 82, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the at least one claim comprises an independent claim (see disclosure that the claims are analyzed in order to identify any dependencies to other claims [and thus identifying independent claims], col. 12, lines 50-57).

26. Regarding claims 9, 33, 59 and 83, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to automatically parse the information contained in the independent claim to identify text corresponding to the preamble and to a claim limitation of the independent claim (see col. 6, lines 60-61; see also col. 11, lines 21-31; see also col. 12, lines 22-67).

27. Regarding claims 13, 37, 63 and 87, **Hammond** additionally teaches a computer-implemented method and apparatus wherein the search query further contains a synonym of the at least one term (see disclosure of the synonym resolver, which expands a query entered by a user by expanding the query so that it contains one or more synonyms of the one or more terms originally entered by the user, col. 7, lines 30-41).

28. Regarding claims 19, 43, 69 and 93, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to generate a claim chart in a plurality of languages (see disclosure that the system can operate to process foreign language documents, col. 16, lines 13-17; see also disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.).

29. Regarding claims 20, 44, 70 and 94, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to automatically perform a search of a publication which references a patent (see disclosure that the system processes a variety of incoming documents from different sources, which would include documents which referenced a patent, col. 11, lines 21-45).

30. Regarding claims 21, 45, 71 and 95, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to automatically ascertain at least one of an inventor and an assignee of the patent (see disclosure that the concept query results screen includes an abbreviated section describing, *inter alia*, inventors and assignees, col. 26, lines 6-21; see also

disclosure that as part of the document clustering function, documents can be displayed by presenting identifying attributes, such as title and author, col. 23, lines 42-59).

31. Regarding claims 22, 46, 72 and 96, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein at least one of a product, products, a service, and services comprises a first product marked with at least one of a patent number and a patent pending notice (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45; since the parent claims cite retrieving information about *any* products, this would include products marked with a patent number or a patent pending notice).

32. Regarding claim 23, **Snyder et al.** additionally teaches an apparatus wherein the processing device generates a claim chart and the claim chart contains preamble text information and text information for at least one claim limitation, and further wherein the claim chart contains information identifying matter in an identified product or service, the matter corresponding to the preamble text information and the text information for the at least one claim limitation (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines

44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34; see also disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C, et seq.).

33. Regarding claims 24, 48, 74 and 98, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the at least one term is at least one of highlighted, underlined and emboldened in the claim chart (see disclosure of the highlighting of terms in the patents, col. 26, lines 22-32; see also drawing Figure 9F).

34. Regarding claims 25, 49, 75 and 99, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the method and apparatus operates automatically (see col. 3, lines 4-18; see also col. 25, lines 39-42).

35. Regarding claims 26, 50, 76 and 100, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the method and apparatus utilize a variety of networks, including an optical communications network [claim 26], an RF signal communications network [claim 50], a wireless communication network [claim 76] and a satellite communications network [claim 100] (see disclosure that the

system includes an interface to outside networks, col. 9, lines 45-51; see also disclosure that the file storage system can be connected via various local area and wide area networks, col. 10, lines 39-41; see also disclosure that the clients and servers may interact with each other *via the Internet or any other communications method*, col. 10, line 64 through col. 11, line 1).

36. Regarding claims 28 and 78, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a server (see server 20 in drawing Figures 1A and 1B).

37. Regarding claims 47, 73 and 97, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device generates a claim chart and the claim chart contains at least one of preamble text information and text information for at least one claim limitation, and further wherein the claim chart contains information regarding whether an identified product or service contains features of a claim preamble of the patent and a claim element or the patent, literally or under the Doctrine of Equivalents (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared

with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34; see also disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C, et seq.).

38. Regarding claims 53 and 79, **Snyder et al.** additionally teaches a computer-implemented method wherein the step of searching comprises searching a database (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45; see also disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34).

39. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **Pedersen et al.** (U.S. Patent 5,278,980).

40. Regarding claim 10, **Snyder et al.** and **Hammond** teach an apparatus substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teach an apparatus wherein the at least one term comprises a first term and a second term and wherein the processing device is further configured to formulate the search query so that the search query imposes a proximity constraint requiring the first term to be found within a predefined proximity of the second term.

Pedersen et al., however, teaches an apparatus wherein the at least one term comprises a first term and a second term and wherein the processing device is further configured to formulate the search query so that the search query imposes a proximity constraint requiring the first term to be found within a predefined proximity of the second term (see disclosure of the use of proximity operators in performing search operations on text documents, col. 3, lines 10-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize proximity operators in a text search operation, since this would enable the user to form phrase-like queries that embody concepts that are not expressible as a single word (see col. 3, lines 22-42).

41. Claims 62, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **Yamada et al.** (U.S. Patent 6,845,486).

42. Regarding claims 62, 86 and 92, **Snyder et al.** and **Hammond** teach an apparatus substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teach an apparatus wherein the processing device is configured to transmit a natural language question to a chat room and obtain the information regarding at least one of a product, products, service and services from the chat room, although **Snyder et al.** does teach that both structured and

non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45.

Yamada et al., however, teaches an apparatus wherein the processing device is configured to transmit a natural language question to a chat room or on-line bulletin board and obtain the information regarding at least one of a product, products, service and services from the chat room (see disclosure that the user can interact directly with a salesperson by posing questions and receiving answers or information on services through a chat function, email or other means, col. 10, lines 5-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow access to chat rooms or on-line bulletin boards, since chat rooms and bulletin boards are Internet-accessible sources of information about products and services, and so a user seeking information regarding a product or service with Internet access would have been motivated to utilize chat rooms and/or on-line bulletin boards.

43. Claims 14, 38, 64 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **Maze et al.** (U.S. Patent Application Publication 2003/0088581).

44. Regarding claims 14, 38, 64 and 88, **Snyder et al.** and **Hammond** teach a computer-implemented method and apparatus substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teach a computer-implemented method and apparatus wherein the at least one term comprises a plurality of terms, and the search query comprises an accuracy constraint requiring the presence of a pre-defined percentage of the terms.

Maze et al., however, teaches a computer-implemented method and apparatus wherein the at least one term comprises a plurality of terms, and the search query comprises an accuracy/integrity constraint requiring the presence of a pre-defined percentage of the terms (see paragraph [0059]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to impose an accuracy/integrity constraint on a query, since this would serve to limit the returned search results to a more manageable amount, displaying to the user only the most relevant results.

45. Claims 15, 39, 65 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **Thomas** (U.S. Patent 6,401,118).

46. Regarding claims 15, 39, 65 and 89, **Snyder et al.** and **Hammond** teach a computer-implemented method and apparatus substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teach a computer-implemented method and apparatus wherein the processing device is configured to automatically perform the search by utilizing a meta search engine, although **Snyder et al.** does teach that both structured and non-structured documents can be searched, said structured

documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45.

Thomas, however, teaches a computer-implemented method and apparatus wherein the processing device is configured to automatically perform the search by utilizing a meta search engine (see drawing Figure 5; see also col. 15, line 31 through col. 16, line 39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a meta search engine, since this would allow the system to provide results from a diverse body of search engines using different search methodologies and strategies, thus returning a more robust search result set than could be produced through the use of a single search engine.

47. Claims 16, 17, 40, 41, 66, 90 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **Barney** (U.S. Patent 6,289,341).

48. Regarding claims 16, 40, 66 and 90, **Snyder et al.** and **Hammond** teach a computer-implemented method and apparatus substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teaches a computer-implemented method and apparatus wherein the processing device is configured to perform the search on a web site associated with at least one of a manufacturer, a wholesaler, and a retailer, of at least one of the product, products, a service, and services, although **Snyder et al.** does teach that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45.

Barney, however, teaches a computer-implemented method and apparatus wherein the processing device is configured to perform the search on a web site associated with at least one of a manufacturer, a wholesaler, and a retailer, of at least one of the product, products, a service, and services (see disclosure of the search of web sites to identify intellectual property infringement issues, col. 1, line 59 through col. 2, line 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform searches of web sites when seeking infringement information, since the Internet is widely used as a distribution medium for products and services, and also since web pages allow for automated searching.

49. Regarding claims 17, 41 and 91, **Barney** additionally teaches a computer-implemented method and apparatus wherein the processing device is configured to perform the search on at least one of advertising information, marketing information, product review information, services review information, manufacturer information and distributor information (see disclosure of the search of web sites to identify intellectual property infringement issues, col. 1, line 59 through col. 2, line 42).

50. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) in view of **Hammond** (U.S. Patent 7,139,755) as applied to claims 1-9, 13, 19-33, 37, 43-59, 63, 69-83, 87 and 93-100 above, and further in view of **CNET** ("Welcome to CNET!").

51. Regarding claim 67, **Snyder et al.** and **Hammond** teach a computer-implemented method substantially as claimed.

Neither **Snyder et al.** nor **Hammond** explicitly teaches a computer-implemented method wherein the step of searching comprises searching product review information, although **Snyder et al.** does teach that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45.

CNET, however, teaches a computer-implemented method wherein the step of searching comprises searching product review information (see under CNET Services the subject headings 'Hardware Reviews', 'Electronics Reviews', and 'Software Reviews').

It would have been obvious to one of ordinary skill in the art at the time of the invention to search product reviews, since product reviews typically provide an overview of new products recently introduced on the market, and as such would likely be among the earliest disclosures of newly infringing products available.

Allowable Subject Matter

52. Claims 12, 18, 36, 42 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

53. The following is a statement of reasons for the indication of allowable subject matter:

Contemporary prior art (such as, for instance, col. 1, lines 26-36 and col. 2, lines 35-47 of **Shwe et al.**, U.S. Patent 6,560,590) discloses the use of agents which can be used in order to automatically *receive* questions and attempt to provide answers to the questions, but fail to disclose the feature of a processing device and method which automatically generates and transmits a natural language question to a chat room or an on-line bulletin board in order to obtain information about a product, products, service or services, as in dependent claims 12, 18, 36, 42 and 68.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119, or sent via email at luke.wassum@uspto.gov, **with a previous written authorization in accordance with the provisions of MPEP § 502.03.** Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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/Luke S. Wassum/
Primary Examiner
Art Unit 2167

lsw
20 February 2008